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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

MONDESI, ROBERT B

ART UNIT PAPER NUMBER

1653

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,223

Applicant(s)

SALOME ET AL.

Examiner

Robert B. Mondesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37.CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to the amendment filed June 14, 2005. **Claims 1-13** are canceled. **Claims 14-24** are new pending and are presently under examination.

Withdrawal of Objections and Rejections

The objections and rejections not explicitly restated below are withdrawn.

New Objection(s) and Rejection(s)

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the newly filed independent **claims 14, 16, 18, 21-24** the applicants have included the limitation "in a configuration used in a potato

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starch factory”; however the specification has not provided any support for the cited phrase besides stating the use of the mentioned configuration in regards to the process of extracting and refining the components of pea flower (specification on page 12, lines 6-8; page 13, lines 24-27; page 15, lines 11-13). There is no actual description of the configuration or an explanation of the exact nature of this configuration. It must be noted that the intended use of the configuration or its advantages cannot be considered as sufficient written description for the particular configuration. **Claims 15, 17, 19** and are dependent claims that do not remedy the deficiencies of the independent claims that they depend from.

Claims 14-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In **claims 14, 16, 18 and 21-24** the applicants have included the limitation “in a configuration used in a potato starch factory”; however nowhere in the claims or the specification of the present application have the applicants explained the nature of the configuration of equipment used in a potato factory. The applicants have indicated intended uses and the advantages of the configuration but they have not provided any information as to the make up of the configurations itself. **Claims 15, 17, 19** and are dependent claims that do not remedy the deficiencies of the independent claims that they depend from.

Maintenance of rejections

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of claims 1-8 now applies to claims 14-24, as these claims are rewrites of the previously rejected claims 1-8.

Claim Rejections - 35 USC § 102

Claims 14-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Nickel United States Patent 5,034,227.

The above rejections were explained in the Office action.

Response to applicant's arguments

The applicant's assert that the claims are redrafted, and now recite that the pieces of equipment are in a configuration used in a potato starch factory and Nickel does not disclose the combination of features recited in claim 24. The applicants also urge that in addition it is clear to those skill in the art, that the configuration used in a starch factory greatly differ according to the nature of the plant being processed and in support of their arguments the applicants have present some references which indicate that the native starch granules greatly differ in size and morphology from one plant to another, the manufacturing process are specific for each plant and the industrial tools are dedicated to one raw material (wheat, corn, or potato in Europe), without it being possible to substitute for the other.

Applicants' arguments have not been found persuasive. The fact that the claims now recite, "configuration used in a potato starch factory" does not overcome the reference since the applicants have not sufficiently defined or explained "configuration

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used in a starch factory". If a person skill in art does not know what is specifically meant by the mentioned configuration then he/she will not be able to decipher the difference between the applicants' method of invention and that of the prior art. Furthermore, applicants' arguments seem to indicate that the method taught by Nickel would not be used in a potato starch factory; therefore the method of the present invention is different than the method of Nickel. The applicants are kindly reminded that the question at hand is whether Nickel teaches the limitations of the claims. However, it would appear that perhaps without intending to, the applicants have missed an opportunity to address more concisely as to why the claims are not anticipated by the mentioned reference. The applicants have minimally stated that Nickel does not teach the combination of features recited in new claim 24 without pointing out what features are not taught. The question remains as to whether the applicants are presently agreeing that the other new claims 14-23 are anticipated by the Nickel reference. If that is not the case, then applicants need to point out what the deficiencies of the reference are in view of the anticipation of the claims. The applicants have stated further that it is clear to a person skill in the art that the configuration used in a starch factory greatly differs according to the nature of the plant material being used. Why is it clear? It is not a trivial task for a person skills in the art to tell the presently difference- wherein the specification and the claims appear to lack a definition for the mentioned "configuration". Also it must be noted that, there is no particular reason to assume that different factories working on different plant material will have different equipment. The examiner can only assume that these arguments are counsel's statements and therefore, are not considered to be

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on par with expert analysis. If the applicants' position is that a person skill in the art would agree with their statements then they should provide their arguments in an affidavit or a declaration. In view of the references provided by the applicants, it must be pointed out that they are neither represented as exhibits nor are they cited on an IDS; it is hard to understand what the point of the submission of these references is, besides the fact that, maybe the applicants are inadequately relying on the references to complete essential missing elements form the response to the rejections. This cannot be considered to be a sufficient attempt to overcome the deficiencies of the cited Nickel reference.

Conclusion

No claims are allowed

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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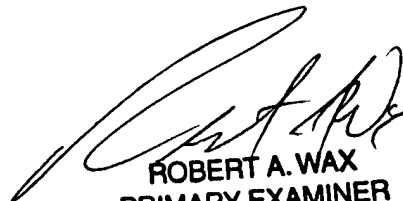
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B Mondesi whose telephone number is 571-272-0956. The examiner can normally be reached on 9am-5pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert B. Mondesi
Patent Examiner
Group 1653

Robert B. Mondesi
08-23-05


ROBERT A. WAX
PRIMARY EXAMINER